

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL D. BEUTHER,
RICHARD J. KAMPS
and KURT W. OSTERMEIER

Appeal No. 2003-1818
Application 09/223,602

HEARD: December 9, 2003

Before COHEN, STAAB, and MCQUADE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Paul D. Beuther et al. originally took this appeal from the final rejection (Paper No. 11) of claims 8 and 10 through 13, all of the claims pending in the application. Upon consideration of the appellants main brief (Paper No. 18), the examiner issued an Office action (Paper No. 19) reopening prosecution and entering superseding rejections of all of the claims. Pursuant to 37 CFR § 1.193(b)(2)(ii), the appellants then filed a supplemental brief (Paper No. 21) and requested that the appeal be reinstated. Implicitly granting the request, the examiner entered an answer

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(Paper No. 24), noted a reply brief (Paper No. 26) filed by the appellants and forwarded the application to this Board for review of the new rejections of claims 8 and 10 through 13.

THE INVENTION

The invention relates to a tissue which is defined in representative claims 8 and 10 as follows:

8. A tissue sheet having a basis weight from about 10 to 25 gsm, a bulk of from about 6 cm³/g to about 15 cm³/g, and a stretch of from about 10% to about 50% in the machine direction; and comprising a Yankee side and an off-Yankee side; the Yankee side having a surface, said surface having a smooth appearance, said surface further being substantially free from any discernable crepe pattern.

10. A single ply creped tissue comprising:
a) a Yankee side and an off-Yankee side;
b) the Yankee side having a smooth appearance and further having no discernable crepe pattern when viewed with the naked eye;
c) the off-Yankee side having a crepe pattern that is visible to the naked eye;
d) a bulk of at least about 6 cm³/g; and,
f) a stretch of at least about 10% in the machine direction.

THE PRIOR ART

The references relied on by the examiner to support the rejections on appeal are:

Salvucci, Jr. et al. (Salvucci)	3,812,000	May 21, 1974
Carstens	4,300,981	Nov. 17, 1981

THE REJECTIONS

Claims 8 and 10 through 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, and in the alternative under 35 U.S.C. § 103(a) as being unpatentable over, Salvucci.

Claim 8 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Carstens.

Claims 8 and 10 through 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carstens.

Attention is directed to the briefs and the answer for the respective positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) and § 103(a) rejections of claims 8 and 10 through 13 based on Salvucci

As framed and argued by the appellants, the dispositive issue with respect to these rejections is whether Salvucci teaches or would have suggested a tissue meeting the limitations in independent claim 8 requiring the tissue sheet to comprise a Yankee side surface which has a smooth appearance and is substantially free from any discernable crepe pattern, and the corresponding limitations in independent claim 10 requiring the tissue to comprise a Yankee side having a smooth appearance and no discernable crepe pattern when viewed with the naked eye.

Salvucci pertains to soft, absorbent, fibrous sheet materials, such as tissues, characterized by high bulk and low density. As described in the reference:

The present invention is a soft, absorbent, creped, fibrous, web formed by deposition from an aqueous slurry. . . . The web is characterized by having a basis weight of from about 10 to about 30 pounds per 2880 ft.², a TEA-to-stiffness ratio greater than 1.50×10^{-4} , and an average calculated density throughout its thickness of no load of less than 0.300 grams per cubic centimeter. . . .

The present invention also is a method for forming the above-described soft, absorbent, creped, fibrous webs or sheet material. In accordance with the method, a fiber furnish is mixed from lignocellulosic fibers, an elastomeric bonding material and water. A web is formed from the fiber furnish by introduction of the fiber furnish [sic] into a drainage zone in which it contacts at least one foraminous support surface which permits the removal of water therefrom [sic]. Additional water is removed from the web without employing mechanical compression until the web is at least 80% dry. The web is then adhered to a creping surface and removed therefrom by a creping blade. In some embodiments, the web is adhered with an adhesive to the creping surface. The method also includes in some instances the steps of applying an adhesive to selected areas of the web such as by printing, and pressing the web into engagement with the creping surface so that only selected areas of the web are adhered to the creping surface [column 4, lines 17 through 55].

Salvucci also discloses specific examples of the web having machine direction stretches of 18.6% and 21.8% (see Examples III and IV), that the creping drum may comprise a Yankee dryer (see column 9, lines 61 through 63), and that the creping blade

imparts a series of fine fold lines to the portions of the web adhered to the drum (see column 10, lines 1 through 15).

In applying Salvucci against claims 8 and 10, the examiner submits that while Salvucci's tissue is not explicitly disclosed as meeting the claim limitations argued by the appellants, the features required by the limitations are inherent in Salvucci's tissue due to the use of similar materials and production steps, and in the alternative, that these features obviously would have been provided by Salvucci's production steps (see page 4 in the answer).¹

Although the tissues respectively claimed by the appellants and disclosed by Salvucci share certain physical characteristics, the steps used to produce these tissues differ in at least one respect deemed quite significant by both Salvucci and the appellants: Salvucci's web is adhered to the Yankee creping drum when at least 80% dry (see column 6, line 5 et seq.), while the appellants web is adhered to Yankee creping drum when 20% to 60% dry (see page 5 in the appellants' specification). This

¹ In actuality, the examiner's position that the features in question obviously would have been provided by Salvucci's production steps amounts to a redundant determination of inherency.

difference casts considerable doubt on the theory underlying the examiner's determinations of inherency and obviousness. More telling, however, is Salvucci's express teaching that the creping blade imparts a series of fine fold lines to the portions of the Salvucci web adhered to the creping drum. The presence of these fold or crepe lines completely belies the proposition that the web inherently or obviously comprises either a Yankee side surface which has a smooth appearance and is substantially free from any discernable crepe pattern as recited in claim 8, or a Yankee side having a smooth appearance and no discernable crepe pattern when viewed with the naked eye as recited in claim 10.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 8 and 10, and dependent claims 11 through 13, as being anticipated by Salvucci, or the standing 35 U.S.C. § 103(a) rejection of claims 8 and 10 through 13 as being unpatentable over Salvucci.

II. The 35 U.S.C. § 102(b) rejection of claim 8 based on Carstens

Carstens relates to layered tissue paper having a velutinous surface subjectively discernible by humans as being extremely soft and smooth, and to tissue paper products comprising one or more plies of such paper (see the Abstract). In Carstens' words:

Such paper has a high degree of subjectively perceivable softness by virtue of being: multi-layered; having a top

surface layer comprising at least about 60% and preferably about 85% or more short papermaking fibers; having an HTR-Texture of the top surface layer of about 1.0 or less, and more preferably about 0.7 or less, and most preferably about 0.1 or less; having an FFE-Index of the top surface of about 60 or more, and preferably about 90 or more. The process for making such paper must include the step of breaking sufficient interfiber bonds between the short papermaking fibers defining its top surface to provide sufficient free end portions thereof to achieve the required FFE-Index of the top surface of the paper. Such bond breaking is preferably achieved by dry creping the paper from a creping surface to which the top surface layer (short fiber layer) has been adhesively secured, and the creping should be effected at a fiber consistency (dryness) of at least about 80% and preferably at least about 95% consistency. Such paper may be made through the use of conventional felts, or foraminous carrier fabrics in vogue today. Such paper may be but is not necessarily of relatively high bulk density [column 4, line 49, through column 5, line 3].

Carstens discloses multiple embodiments of this tissue paper. Figure 1 illustrates a two-layer design having the following general characteristics:

A line drawing sectional view of an exemplary paper sheet 70 embodying the present invention is shown in FIG. 1 to comprise a top layer 71 having a velutinous top surface 72 defined by free fiber ends 73 of relatively short papermaking fibers 74, and a second layer 75 of fibrous papermaking material such as relatively long papermaking fibers 76. The top surface 72 is also referred to as the Yankee-side of paper 70, and the opposite side is also referred to as the off-Yankee-side because of their respective orientations with the Yankee dryer surface when made as described below. Paper 70, preferably has a total basis weight of from about 6 to about 40 pounds per 3,000 square feet (about 10 to about 65 grams per square meter), and layer 71 preferably has a basis weight of from about 3 to

about 35 pounds per 3,000 square feet (about 5 to about 57 grams per square meter), which basis weights are with respect to paper 70 in an uncreped state. More preferably, the total basis weight of paper 70 is from about 7 to about 25 pounds per 3,000 square feet (about 11 to about 41 grams per square meter) and the basis weight of layer 71 is from about 3 to about 20 pounds per 3,000 square feet (about 5 to about 33 grams per square meter) as measured in an uncreped state [column 7, line 47, through column 8, line 2].

Table Ib in column 10 of the reference enumerates certain parameters, including basis weight, bulk density and machine direction stretch, for five specific examples of Carstens' two-layer design. Figures 37, 38 and 39 depict alternative embodiments which are generally described, without specific parameters, at column 20, lines 35 through 68. Examples 1 through 5 (see columns 23 through 34) pertain to still further embodiments whose parameters, including basis weight, bulk density and machine direction stretch, are listed in Tables VI through X, respectively.

In rejecting claim 8 as being anticipated by Carstens (see page 3 in the answer), the examiner relies on the specific examples of Carstens' two-layer tissue design summarized in Table Ib and, in apparent appreciation of the fact that these particular examples do not meet the basis weight limitation in claim 8, on the general basis weight ranges for the two-layer tissues set forth in the above reproduced passage bridging

columns 7 and 8, and additionally on the three-layer design shown in Figure 38. It is well settled, however, that anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose and combine various portions of the disclosure not directly related to each other by the teachings of the reference. In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). In the present case, the examiner has not pointed to any teaching in Carstens, and none is apparent, which directly relates the tissue examples described in Table Ib, which have specific bulks and machine direction stretches meeting the corresponding limitations in claim 8 and a specific basis weight which does not, to the broad range of basis weights preferred by Carstens for this particular tissue construction and/or to the broadly described three-layer tissue shown in Figure 38.

Thus, the examiner's application of Carstens as an anticipatory reference against the subject matter recited in claim 8 is unsound. Hence, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 8 as being anticipated by Carstens.

III. The 35 U.S.C. § 103(a) rejection of claims 8 and 10 through 13 based on Carstens

The examiner's rather ambiguous explanation of this rejection (see page 5 in the answer) indicates that it rests on an eclectic combination of the two-layer tissue parameters summarized in Table Ib, the general basis weight ranges for two-layer tissues set forth in the passage bridging columns 7 and 8, the bottom layer of the two-layer tissue shown in Figure 1, the bottom layer of the three-layer tissue shown in Figure 38, and some unfounded assumptions regarding the stretchability and bulk density of the bottom layers. In short, the only suggestion for this proposed combination stems from hindsight knowledge impermissibly derived from the appellants' disclosure.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 8 and 10 through 13 as being unpatentable over Carstens.

SUMMARY

The decision of the examiner to reject claims 8 and 10 through 13 is reversed.

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REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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)	APPEALS AND
LAWRENCE J. STAAB)	
Administrative Patent Judge)	INTERFERENCES
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Administrative Patent Judge)	

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